IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT APPLICATION OF:	Michael ZIRNGIBL *et al.*
SERIAL NO.:	09/455,534
FILING DATE:	December 7, 1999
ART UNIT:	2645
EXAMINER	M. CHOW
FOR:	SYSTEM AND METHOD FOR THE CREATION AND AUTOMATIC DEPLOYMENT OF PERSONALIZED, DYNAMIC AND INTERACTIVE VOICE SERVICES, WITH INTEGRATED INBOUND AND OUTBOUND VOICE SERVICES

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

In response to the Final Office Action mailed **July 14, 2005** (hereinafter "Final Action"), Applicants request a review of the Final Rejection in the above-referenced application. This request is being filed concurrently with a Notice of Appeal.

The review is requested for the reasons set forth in the **Remarks** beginning on page **2** of this paper.

A total of **5** pages are provided.

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. § 1.136(a), and are hereby authorized to be charged to our Deposit Account No. 033975 (**Ref. No. 067220-0313100**).

REMARKS

Claims 1-18 and 23 are pending in this application. Claims 1-18 stand rejected, and claim 23 is allowed. In view of the following comments, allowance of all the claims pending in the application is respectfully requested.

REJECTIONS UNDER 35 U.S.C. §102

Review is requested for the rejection of claims 1, 2, 4-6, 10, 11, and 13-15 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,445,694 to Swartz. *See* Final Action, pg. 3, ¶1. The rejection of claims 1, 2, 4-6, 10, 11, and 13-15 under 35 U.S.C. §102(e) is improper for at least the reason that Swartz fails to disclose at least the following features recited in independent claims 1 and 10:

> ...generating markup documents personalized for subscribers of at least one voice service, wherein the markup documents include voice service output information derived from a data repository;
>
> ...accesses (claim 1) or accessing (claim 10) one or more of the markup documents for dynamically interacting with one or more subscribers of the at least one voice service, during either outbound or inbound voice-enabled communications, to enable the one or more subscribers to receive and respond to the voice service output information.

Swartz discloses a telephone system which may be controlled using commands transmitted from a subscriber location over the Internet to a host computer which provides telephone services. *See* Swartz, *e.g.*, col. 1, lines 10-15. The Internet telephony system of Swartz enables a subscriber to utilize a web interface to populate a database with preference data that is used by a host services processor to handle incoming calls and establish outgoing telephone connections. *See* Swartz, *e.g.*, Abstract, and FIG. 1. Swartz appears to enable subscribers to use the web interface to, among other things: place outgoing calls; control call waiting, caller ID, and call tracing; store frequently called numbers in a phone book; and specify call forwarding, message routing, and paging service options.

Unlike Applicants' invention, as disclosed and claimed, Swartz does not disclose generating markup documents personalized for subscribers of at least one voice service, wherein

the markup documents include voice service output information derived from a data repository, and dynamically interacting with one or more subscribers of the at least one voice service, during either outbound or inbound voice-enabled communications, to enable the one or more subscribers to receive and respond to the voice service output information presented from the one or more markup documents.

For *at least* the reason that Swartz fails to disclose each of the elements of independent claims 1 and 10, the rejection is improper and should be withdrawn. Dependent claims 2-9 and 11-18 are allowable because they depend from allowable independent claims, as well as for the further limitations they contain.

REJECTIONS UNDER 35 U.S.C. §103

A. Swartz in view of Brown, Ladd, and Rogers.

Review is requested for the rejections, under 35 U.S.C. §103(a), of dependent claims 3 and 12 over Swartz in view of U.S. Patent No. 6,587,822 to Brown *et al.* (*see* Final Action, pg. 5, ¶2); of dependent claims 7, 8, 16, and 17 over Swartz in view of U.S. Patent No. 6,269,336 to Ladd *et al.* (*see* Final Action, pg. 5, ¶3); and of dependent claims 9 and 18 over Swartz in view of U.S. Patent No. 5,974,441 to Rogers *et al.* (*see* Final Action, pg. 6, ¶4). These rejections are improper for *at least* the reason that the Examiner has failed to establish a *prima facie* case of obviousness.

As noted by Applicants in pgs. 11-13 of the "Response to Non-Final Office Action" filed June 24, 2005, the Examiner's recited motivation for each of the aforementioned combinations is legally improper for *at least* the reason that it states what the result of the combination of the references would be, but fails to demonstrate any teaching, suggestion, or motivation found in either Swartz or the secondary references themselves, or in the knowledge generally available to one of ordinary skill in the art, as to why it would have been obvious to modify Swartz to include the teachings of the secondary references. As but one illustrative example, Applicants note the rejection of claims 3 and 12 over Swartz in view of Brown *et al.*:

> It would have been obvious to one skilled at the time the invention was made to modify Swartz to have the "parser" as taught by Brown et al such that the

> modified system of Swartz would be able to support the system users convenience of extracting markup documents by using a parser. *See* Final Action, pg. 5, ¶2.

The Examiner *appears* merely to be stating that it would be obvious to modify Swartz to include the teachings of the secondary references (in this instance, Brown) so that the users of Swartz's system would have the convenience of using the features allegedly taught by the secondary references. This is legally improper. For *at least* this reason, the Examiner has failed to set forth a *prima facie* case of obviousness under 35 U.S.C. §103(a). Applicants maintain the arguments presented in pgs. 11-13 of the June 24, 2005 Response referenced above.

B. Liebesny in view of Swartz.

Review is requested for the rejection of claim 1 under 35 U.S.C. §103(a) over U.S. Patent No. 5,131,020 to Liebesny *et al.* ("Liebesny") in view of Swartz. *See* Final Action, pg. 6, ¶5. The rejection is improper because there is no legally proper teaching, suggestion, or motivation to modify Liebesny to include the teachings of Swartz; and assuming arguendo that there was a legally proper teaching, suggestion, or motivation to combine Liebesny and Swartz, the references, even if combined, fail to disclose, teach, or suggest all of the claim elements.

In the Final Action, at pg. 6, ¶5, the Examiner alleges that Liebesny teaches each of the features of claim 1, with the exception of the use of markup documents. The Examiner relies on Swartz, however, for this teaching, alleging:

> It would have been obvious to one skilled at the time the invention was made to modify Liebesny et al to have the "markup documents" as taught by Swartz such that the modified system of Liebesny et al would be able to support the system users convenience of providing voice communications via markup documents.

The Examiner's recited motivation is legally improper for *at least* the reason that it states what the result of the combination of the references would be, but fails to demonstrate any teaching, suggestion, or motivation found in either Liebesny or Swartz themselves, or in the knowledge generally available to one of ordinary skill in the art, as to why it would have been obvious to modify Liebesny to include the teachings of Swartz. The Examiner *appears* merely to be stating that it would be obvious to modify Liebesny to include the use of markup documents so that the system of Liebesny would be able to support providing voice communications via

markup documents. This is legally improper. For *at least* this reason, the Examiner has failed to set forth a *prima facie* case of obviousness under 35 U.S.C. §103(a). Accordingly, the rejection of claim 1 is improper and should be withdrawn.

Assuming arguendo that Liebesny and Swartz could be combined, the combined references fail to disclose, teach, or suggest all of the elements of claim 1. Specifically, neither Liebesny nor Swartz, either alone or in combination, disclose the features of generating markup documents personalized for subscribers of at least one voice service, wherein the markup documents include voice service output information derived from a data repository, and dynamically interacting with one or more subscribers of the at least one voice service, during either outbound or inbound voice-enabled communications, to enable the one or more subscribers to receive and respond to the voice service output information presented from the one or more markup documents. Accordingly, the rejection of claim 1 is improper and should be withdrawn.

For *at least* each of the foregoing reasons, the Examiner has failed to establish a prima facie case of obviousness. Accordingly, independent claim 1 is patentable over Liebesny in view of Swartz.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: **November 14, 2005**

Respectfully submitted,

By: _____

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